

### **REMARKS**

By this Amendment, Applicants propose to cancel claims 3 and 4, without prejudice or disclaimer, and amend claim 1. Claims 1, 2, 5, 7-11, 13-18, and 20 remain pending.

In the Final Office Action<sup>1</sup>, the Examiner rejected claims 1-5, 7-11, 13-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,213,780 to Ho et al. ("Ho").

Applicants propose to cancel claims 3 and 4, without prejudice or disclaimer. Accordingly, the rejection of claims 3 and 4 under 35 U.S.C. § 103(a) is moot.

Applicants respectfully traverse the rejection of independent claim 1 and dependent claims 2, 5, 7-11, 13-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Ho. A *prima facie* case of obviousness cannot be established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142.

At least the first requirement for establishing a *prima facie* case of obviousness cannot be met because Ho does not teach or suggest each and every element of Applicants' independent claim 1.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement of characterization in the Office Action.

In particular, Ho at least fails to teach or suggest a method including “determining audience segments of the organization based on the categories to gather data related to the roles of the organization,” as recited in amended claim 1.

Ho discloses a computer-aided learning method for counseling and training a user for a job position (see column 2, lines 14-17). Job positions may be classified in a hierarchy of job positions and may be further classified into sub-jobs (see column 5, lines 56-60). For example, Figure 4 of Ho illustrates a Job Position 250 with Job 1, Job 2, etc. below Job Position 250, and Job 2 with Sub-job 1 and Sub-job 2 below Job 2.

Classifying job positions into a hierarchy of job positions, however, is not the same as and does not teach or suggest, “determining audience segments of the organization based on the categories to gather data related to the roles of the organization,” as recited in amended claim 1.

In connection with the rejection of cancelled claim 3, the Examiner asserted that audience segments are identified based on the needs of the organization. However, “identify[ing] sales personnel that need to understand the Russian culture in order to sell products in Russia” is not the same as “determining audience segments of the organization based on the categories to gather data related to the roles of the organization,” which is now recited in claim 1.

Furthermore, Ho fails to teach or suggest a method including “identifying subject matter experts from the audience segments of the organization,” as recited in amended claim 1. On page 6 of the Office Action, the Examiner alleges that it is old and well-known for a human resources department to either have subject matter experts for roles in the organization or to at least maintain such information from subject matter experts

to be able to place people in appropriate roles in the organization. However, this is different from, "identifying subject matter experts from the audience segments of the organization," as recited in amended claim 1 because the audience segment is a group of workers that are part of a role category and a subject matter expert is a person knowledgeable about the audience segment and part of an audience segment.

The Examiner also asserted in connection with the rejection of claim 4 that Ho teaches identifying subject matter experts in the organization based on the audience segment. Applicants submit that using a "learning determinant [that] distinguishes between users who have skills, knowledge or training (i.e., subject matter expertise) and those that do not" is not the same as "identifying subject matter experts from the audience segments of the organization," which is now recited in claim 1 because the audience segment is a group of workers that are part of a role category and a subject matter expert is a person knowledgeable about the audience segment and part of an audience segment.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 2, 5, 7-11, 13-18, and 20 in condition for allowance. Applicants submit that the proposed amendments of claim 1 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art

references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

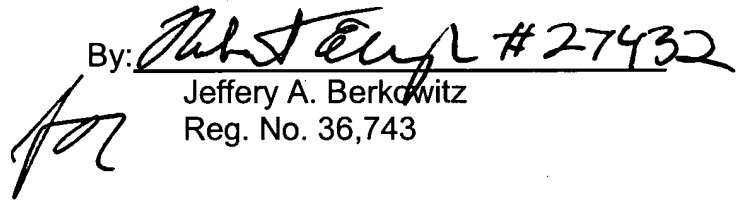
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 13, 2007

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